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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/714,658

11/16/2000

Mark D. Gehlsen

53786USASB.012

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7590

11/25/2003

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EXAMINER

CHANG, VICTOR S

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 11/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/714,658

Applicant(s)

GEHLSSEN ET AL.

Examiner

Victor S Chang

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26, 29-32, 34-36, 43 and 47-61 is/are pending in the application.
- 4a) Of the above claim(s) 43, 47, 48 and 51-54 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26, 29-32, 34-36, 49, 50, 55-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. The Examiner has carefully considered Applicant's amendments and remarks filed on 9/10/2003. Applicant's amendment to claim 1 has been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn. In particular, Applicants' argument that "A-B-A triblock copolymers are not inherently pressure-sensitive adhesives by themselves" and "the rubber must be compounded with tackifying resin ... to develop required tack" (Remarks, page 12) appears persuasive. As such, the rejection of claims 55 and 56 under 35 U.S.C. 103(a) as being unpatentable over Hartman et al. (US 5476712) either individually, or in view of Sieverding (US 4833193) is withdrawn.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
5. Claims 1-26, 29-32, 34-36, 49, 50 and 55-61 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

It is noted that newly amended claim 1, lines 3-4, and newly added claim 61, lines 4-5, each now recites in part "said polymer foam being smooth without being bonded to an additional layer". However, Applicants fail to provide any express or inherent support in the Specification, and the amendment appears to be new matter.

Further, it is noted that claims 55 and 56 each recites in part "polymer foam is capable of stretch activated release". The Examiner notes that "stretch activated release" pertains to an adhesive property. As such, the recitation "polymer foam" is clearly unduly broad and in excess of disclosure.

#### ***Response to Amendment***

6. Claims 23-26, 29-32 and 34-36, 49, 50 and 57-60 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hartman et al. (US 5476712), substantially for the reasons set forth in section 10 of Paper No. 11, together with the following additional observations.

While newly amended claim 1, if proper support is provided, appears persuasive to overcome the prior rejection as anticipated by or obvious over Hartman for claims 1-6, 9-12, 17, 19-22 and newly added 61, it is noted that the rejection for claims 23-26, 29-32 and 34-36, 49, 50 and 57-60 are still deemed to be proper, since independent claim 23 has not been similarly amended, and claims 57-60 recite in part "further comprising at least one layer ... said layer bonded to said polymer foam.", which still clearly reads on the Hartman reference.

With respect to Applicants' argument that "Discussing attributes of an article described in a patent reference is not included in the examples provided in MPEP section 716.01(c)." (Remarks, page 10, third paragraph), the Examiner notes that Applicants appear to have admitted that "The skin layer levels the roughness to provide a carrier layer that is smooth" (Remarks, page 10, 4<sup>th</sup> paragraph), whereas in the Remarks filed 7/8/2003, the attorney continually argues that the carrier layer being rough (Remarks dated 7/8/2003, page 3, second full paragraph), as such, the attorney appears arguing unexpected results, and factual evidence is deemed to be necessary.

Similarly, regarding Applicants' contention that the Examiner reiterates that Applicants' argument that "the die used in US '712 is designed such that the pressure drops outside the die. Consequently, the microspheres are not expanded until the molten material exits the die" (Remarks, page 11) appears to be unexpected results, and factual evidentiary support is required.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 703-605-4296. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 703-308-2414. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Application/Control Number: 09/714,658  
Art Unit: 1771

Page 5

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DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP ~~1360~~  
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*Daniel Zinker*